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EXAMINER
CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
2436	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 April 2010</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-27</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>08 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments filed 4/30/10 have been fully considered.

2. Claims 1-27 are pending and have been examined.

Response to Amendment

3. The provisional Double Patenting rejection is withdrawn in view of the Terminal

Disclaimers filed on 1/30/2009.

4. Upon further search, a new obviousness-type Double Patenting rejection is

introduced in view of patents 7600124 and 7650512.

Terminal Disclaimer

5. The terminal disclaimers filed on 1/30/2009 disclaiming the terminal portion of

any patent granted on this application which would extend beyond the expiration date of

US Applications 10/731299 and 10/731655 have been reviewed and are accepted. The

terminal disclaimers have been recorded.

Double Patenting

6. Claims 1-27 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-22 of US

Patent 7600124 and over claims 1-22 of US Patent 7650512. Although the conflicting

claims are not identical, they are not patentably distinct from each other because

> - "A method of intercepting a transaction instantiated by a database
>
> application to determine if an electronic signature is necessary to commit
>
> the transaction to the database, the method comprising: in response to a
>
> triggering action generated by the database application, calling an

application program interface to raise an event indicative of a signature

collection process; initiating a workflow process defined by the event that

initiates the transaction instantiated by the database application with the

database without committing the initiated transaction to the database;

executing a rule specified by the workflow process to determine if an

electronic signature is required to approve the transaction; and if

execution of the rule results in a determination that an electronic

signature is required for the initiated transaction to be committed to the

database, instantiating the signature collection process" (claim 1, instant

application) is analogous to

- "A computer-implemented method of associating an electronic signature

with an electronic record, the method comprising: receiving, at a

computer system configured to manage a database of electronic records,

first information provided by a user via a graphical user interface

configured to enable users of the computer system to define operations

by one or more database applications as triggering conditions for

application events monitored by the computer system and processing

that occurs when the application events are triggered, the first

information defining an application event that, upon occurrence, causes

the computer system to intercept a database transaction instantiated by

one of the database applications with a database management system of

a database and generate from data identified in the database transaction

an electronic record that requires an electronic signature; receiving, at

the computer system, second information provided by the user via the

graphical user interface, the second information defining one or more

fields for data to be stored in the electronic record; receiving, at the

computer system, third information provided by the user via the graphical

user interface, the third information providing a mapping between data

from underlying database tables associated with the database

transaction to at least some of the fields defined for data to be stored in

the electronic record; receiving, at the computer system, fourth

information provided by the user via the graphical user interface, the

fourth information defining a layout that is applicable when an electronic

signature is collected for the electronic record for displaying data stored

in the electronic record on a computer display; receiving, at the computer

system, fifth information provided by the user via the graphical user

interface, the fifth information identifying a signatory approver for the

electronic record; in response to detecting the occurrence of the

application event at the computer system when the one of the database

applications instantiates the database transaction associated with the

application event with the database management system of a database,

automatically generating the electronic record with the computer system

from data intercepted from the database transaction according to the

mapping between the data from the underlying database tables

associated with the database transaction to the at least some of the

fields in the electronic record; displaying the electronic record using the

computer system to the signatory approver according to the defined

layout in order to collect an electronic signature for the electronic record;

receiving, at the computer system, an electronic signature from the

signatory approver for the electronic record; and generating, by the

computer system, sixth information associating the electronic signature

from the signatory approver with the electronic record prior to performing

an action with the computer system that results in committing the

database transaction to the database associated with the database

management system" (claim 1, US Patent 7600124) and to

- "A computer-implemented method of searching unstructured data stored

in a database, the method comprising: receiving, at a first set of one or

more computer systems, information indicative of a set of one or more

application events that, upon occurrence, cause the first set of one or

more computer systems to intercept database transactions instantiated

by database applications with a database management system of the

database and to generate electronic records from data in underlying

database tables associated with execution of operations by the database

applications identified in the database transactions; storing, using the first

set of one or more computer systems, a plurality of electronic records

created based on mappings between underlying database tables

associated with execution of operations by the database applications and

the plurality of electronic records in response to occurrence of the set of

one or more application events in a common repository of electronic

records in the database that provides an audit trail that cannot be altered

or disabled by users associated with the database, wherein each

electronic record comprises unstructured data stored in a character

large-object (CLOB) format in a column of a table of the database;

forwarding, to a client computer, information configured for generating a

first graphical user interface, the first graphical user interface configured

to enable users of the first graphical user interface to identify one or more

references to sections of unstructured data within the plurality of

electronic records stored in the database as elements of security rules;

receiving, at a second set of one or more computer systems, information

from a user via the first graphical user interface identifying a reference to

a section of unstructured data within an electronic record stored in the

database as an element of one or more security rules; generating, using

the second set of one or more computer systems, the one or more

security rules in response to the information from the user identifying the

reference to a section of unstructured data within the electronic record as

an element of the one or more security rules; creating, using the second

set of one or more computer systems, a security protocol that protects

the plurality of electronic records stored in the database against

unauthorized access based on the one or more security rules; receiving,

at a third set of one or more computer systems, a query designed to

identify a set of electronic records stored in the database that meet

criteria designated in the query; prior to executing the query at the

database management system, modifying the query using the third set of

one or more computer systems in accordance with the security protocol

to create a modified query that includes the reference to a section of

unstructured data within the electronic document identified by the user as

an element of the one or more security rules; and running, using the

database management system, the modified query against the

unstructured data of the plurality of electronic records stored in the

database" (claim 1, US Patent 7650512).

7.   This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims of the instant application have not in fact been patented.

8.   Claims 1-22 of US Patent 7600124 and claims 1-22 of US Patent 7650512 contain every element of claims 1-27 of the instant application and thus anticipate the claims of the instant application. Claims 1-27 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

9.   "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. <u>In re Longi</u>, 759 F.2d at

896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

10.   "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

Allowable Subject Matter

11.   Claims 1-27 would be allowed over the prior art.

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to David García Cervetti whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

13.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/
Primary Examiner, Art Unit 2436